

REMARKS/ARGUMENTS

The Office Action mailed May 17, 2004 has been carefully reviewed. Reconsideration of this application, as amended and in view of the following remarks, is respectfully requested. The claims presented for examination are: claims 1-3 and 8-12.

35 USC 103 Rejection

In numbered paragraph 4 of the Office Action mailed May 17, 2004 claims 1-3 and 8-12 were rejected under 35 USC 103(a) as allegedly being unpatentable over the primary Boppart et al reference (U.S. Patent No. 6,485,413) in view of the secondary Von Bargen reference (U.S. Patent No. 5,708,273) and the tertiary Pitris et al reference (U.S. Patent No. 6, 564, 087).

Applicants have amended claims 1-3 and 8-12. Since claim claims 1-3 and 8-12 now appear in amended form the 35 USC §103(a) rejection in the Office Action mailed May 17, 2004 no longer applies.

Applicants respectfully submit that amended claims 1-3 and 8-12 presented for examination are patentable over the primary Boppart et al reference and the secondary Von Bargen reference and the and the tertiary Pitris et al reference and any legitimate combination of the primary Boppart et al reference and the secondary Von Bargen reference and the tertiary Pitris et al reference.

Amended Claim 1

Amended claim 1 provides, "A system for characterizing tissue and to correct for optical fluctuations, consisting of: .... " As stated in MPEP § 2111.03, "The transitional phrase 'consisting of' excludes any element, step, or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948)."

The primary Boppert et al reference states, "Referring to FIG. 2, the optical source 10 is coupled to a 2:2 fiber optic splitter 14 containing paths to a reference mirror 18 (corner cube) and to a probe unit 22 that illuminates the sample. Additional sources or aiming laser could be connected to unused coupler 14 (not shown). The beam waist of the illumination port 26 of the probe unit 22 is offset from the beam waist of the receiver port 30 of the probe unit 22 by a three dimensional vector  $R$  and a two dimensional coordinate rotation  $\Theta$ . The light from the receiver port 30 is recombined with the light reflected from reference mirror 18 into a 50/50 optical combiner 34 to form signals that enter the receiver processor 38 whose output is analyzed by a computer 42." The primary Boppert et al reference, the secondary Von Bargen reference, and the tertiary Pitris et al reference all include significant structure that is outside of amended claim 1.

There is no teaching of combining the primary Boppert et al reference, the secondary Von Bargen reference, and the tertiary Pitris et al reference to meet Applicants' amended claim 1. Thus, there is no legitimate combination of references that would support a rejection of amended claim 1 under 35 USC 103, and the rejection of amended claim 1 should be withdrawn.

#### Claims 2, 3, 8, 9, 10, and 11

Claims 2, 3, 8, 9, 10, and 11 depend from amended claim 1; therefore, the comments above also apply to claims 2, 3, 8, 9, 10, and 11.

#### Amended Claim 12

Claim 12 has been amended, and Applicants submit that amended claim 12 is patentable over the primary Boppert et al reference and the secondary Von Bargen reference and the and the tertiary Pitris et al reference and any legitimate combination of the primary Boppert et al reference and the secondary Von Bargen reference and the tertiary Pitris et al reference.

The differences between the Boppart et al reference and Applicants' invention defined by amended claims 12 includes the fact that the following elements of amended claim 12 are not shown by the primary Boppart et al reference:

"a probe with a needle that is inserted into the tissue for tissue identification, said needle having a first end and a distal end," or

"a laser for producing an optical tissue illuminating emission signal," or

"an emission optical scattering and absorption spectroscopy sensor connected to said controller and to said probe and to said needle and configured to deliver and receive said optical tissue illuminating emission signal from said probe and said needle," or

"an emission optical fiber connected to said controller and connected to said probe and said needle that extends to said distal end of said probe for tissue identification and connected to said emission optical scattering and absorption spectroscopy sensor," or

"a reference optical scattering and absorption spectroscopy sensor connected to said controller and to said probe and configured to deliver and receive said optical tissue illuminating emission signal from said probe," or

"a reference optical fiber connected to said controller and connected to said probe that extends to said probe but does not extend to said distal end of said needle and that is connected to said reference optical scattering and absorption spectroscopy sensor that improves said systems accuracy by reducing the effects of optical source fluctuations and changes in the fiber optic efficiency."

The secondary Von Bargen reference and the tertiary Pitris et al reference do not provide the missing elements of Applicants' amended claim 12. Since none of the references show the elements of Applicants' amended claim 12, there

can be no combination of the elements that would produce the combination of elements of Applicants' amended claim 12.

Further, there is no teaching of combining the primary Boppart et al reference, the secondary Von Bargaen reference, and the tertiary Pitris et al reference to meet Applicants' amended claim 12. Thus, there is no legitimate combination of references that would support a rejection of amended claim 12 under 35 USC 103, and the rejection of amended claim 12 should be withdrawn.

SUMMARY

The undersigned respectfully submits that, in view of the foregoing amendments and the foregoing remarks, the rejections of the claims raised in the Office Action dated May 17, 2004 have been fully addressed and overcome, and the present application is believed to be in condition for allowance. It is respectfully requested that this application be reconsidered, that the claims be allowed, and that this case be passed to issue. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to call the undersigned attorney at (925) 424-6897.

Respectfully submitted,



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